

Remarks

Claims 1 to 16 are pending of which only claim 1 is in independent form. Claims 1, 2, 4, 8, 9, 11 to 14 and 16 are amended.

In paragraph 3, the Office objected to the specification because element number 1 was used to designate both "the transition section" in line 5 of page 6 and "the antivibration element" in line 2 of page 5.

In response, applicants have amended the specification to replace element number "1" with element number -- 11 -- in line 5 of page 6.

In paragraph 4, the Office objected to claim 4, in particular, to the phrase "said number of turns"

In response, applicants have amended claim 4 to insert -- said -- before "turns" in accordance with the Office's suggestion.

In paragraphs 5 and 6, the Office rejected claims 4, 5, and 9 to 16 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In particular, the Office appeared to have rejected claims 4, 5 and 15 for reciting a smaller range limitation than the range limitation of the claim they are dependent upon. The Office equates these smaller range limitations to "such as" language in claims.

While applicants agree that exemplary language including "such as" in a claim might render a claim indefinite, applicants submit that the current smaller range limitations do not (MPEP 2173.05(d)). Applicants submit that the rejected claim format meets the threshold of a reasonable degree of clarity and particularity (MPEP §2173.02). In fact, applicants submit that the claiming of narrower ranges within a larger range has been accepted as a way of claim differentiation.

The Office also rejected the limitation "said first and second guide members" in lines 1 and 2 of claim 9 for lack of antecedent basis.

In response, applicants have amended claim 9 to be dependent from claim 8 where proper antecedents are provided.

The Office also rejected the limitation "said slot" in line 3 of claim 12 expressing the view that it was not clear to which "slot" applicants referred.

In response, applicants have clarified the claim by referring to -- spirally-shaped guide slots --.

In paragraphs 7 and 8, the Office rejected claims 1 to 3, 6, 8, 9 and 11 under 35 U.S.C. §102(b) as anticipated by United States Patent 4,712,778 to Newman.

Newman discloses a holder for a helical spring which is subject to tension or compression forces. The helical spring is mounted in a slot, wherein the spring is in contact engagement with the sides of the slot and has a distance to the base of the slot. In order to obtain equal numbers of turns of the coil in tension and in compression, the slot side along the last turn of the coil, which is guided on the plug, is provided with a cutout

so that the helical spring does not, when subjected to compression forces, lie against the turn of the coil. This avoids that a turn of the helical spring is guided at only one side. The plugs are accordingly constructed to ensure that the helical spring either contacts both or none of the sides of the slot.

In contrast, the applicants' invention provides an antivibration element in which the entire antivibration element has a different spring constant for different states of loading (page 1, lines 16 to 18). Applicants submit that Newman does not disclose the use of his spring for antivibration. To emphasize this difference, applicants have amended claim 1 so than a reference to an antivibration element is present in the body of the claim.

Amended claim 1 further requires:

"said transition section being guided on said guide slot with play (b) to said base of said guide slot, wherein said play (b) increases with increasing distance from said end sections" (emphasis added)

Applicants submit that Newman does not disclose such a increase of play. Rather, Newman's helical spring maintains constant play over the entire length to the base of the slot.

Because of the increase in play (b) with increasing distance from the end section as set forth in amended claim 1, the contact engagement of the coil spring occurs fairly continuously. Consequently and advantageously, the change of the stiffness of the spring does not occur abruptly but continuously because of the change of the number of turns of the coil.

In contrast to the applicants' invention and as noted above,

Newman provides a helical spring which is at constant play to the base of the slot over its entire length.

In view of the above, applicants submit that Newman does not disclose all elements of claim 1, as amended, as required for a rejection under 35 U.S.C. §102(b) so that claim 1 should now patentably distinguish their invention over this reference.

In paragraph 9, the Office rejected claims 1, 9, 10, 11 and 16 under 35 U.S.C. §102(b) as anticipated by United States Patent 1,878,128 to Griswold.

Griswold is directed to a valve spring. The present invention is directed to an antivibration element. Applicants submit that Griswold is not within the field of applicants' endeavor, and is not reasonably pertinent to the particular problem with which the inventors of the present invention were concerned. Applicants submit that the person of ordinary skill, seeking to solve a problem of antivibration, would not reasonably be expected or motivated to look to valve springs (MPEP §2141.01). Accordingly, applicants respectfully submit that Griswold is non-analogous art and was not properly applied against the specified claims.

In paragraphs 10 and 11, the Office rejected claims 4 and 5 under 35 U.S.C. §103(a) as obvious over Newman in view of United States Patent 4,886,250 to Lucas.

The Office acknowledged that Newman does not disclose the specific number of turns as claimed.

However, the view was expressed that it would have been obvious to one of ordinary skill in the art to modify the number of turns in view of the disclosure of Lucas.

The deficiencies of Newman have been outlined above.

Applicants submit that Lucas does not cure these deficiencies.

Applicants submit that Newman and Lucas when combined do not teach or suggest all the claim limitations as required for a *prima facie* case of obviousness. Applicants further submit that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Newman or to combine the teachings of Newman and Lucas. Finally, applicants submit that there is no reasonable expectation of success (MPEP §2142).

In paragraph 12, the Office rejected claim 10 under 35 U.S.C. §103(a) as obvious over Newman in view of United States Patent 4,905,574 to Trevisan.

The Office acknowledged that Newman does not specifically disclose the means for accommodating the attachment device being in the form of receptacles formed in the first and second plugs.

However, the view was expressed that it would have been obvious to one of ordinary skill in the art to modify the means of connecting the attachment device to the first and second plugs in view of Trevisan.

The deficiencies of Newman have been outlined above.

Applicants submit that Trevisan does not cure these deficiencies. Applicants further submit that Trevisan discloses a compression coil spring the ends of which are engaged by flanged cups and are carried on pin 8. The pin 8 limits the maximal length of the spring and keeps the spring under tension. Applicants submit that Trevisan does not disclose an attachment device for the spring.

Applicants submit that Newman and Trevisan when combined do not teach or suggest all the claim limitations as required for a *prima facie* case of obviousness. Applicants further submit that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Newman or to combine the teachings of Newman and Trevisan. Finally, applicants submit that there is no reasonable expectation of success (MPEP §2142).

In paragraph 13, the Office rejected claims 12 to 15 under 35 U.S.C. §103(a) as obvious over Newman in view of United States Patent 3,779,537 to Kalister.

The Office acknowledged that Newman does not disclose the limitation of the spacing of the base of the slot to the longitudinal center axis becoming less with increasing distance from the end section.

However, the view was expressed that it would have been obvious to one of ordinary skill in the art to modify the guide members of Newman in view of the disclosure of Kalister.

The deficiencies of Newman have been outlined above.

Applicants submit that Kalister does not cure these deficiencies.

In addition, applicants submit that Kalister discloses a torsion spring. The present invention is directed to an antivibration element. Applicants submit that Kalister is not within the field of applicant's endeavor, and is not reasonably pertinent to the particular problem with which the inventors of the present invention were concerned. Applicants submit that the person of ordinary skill, seeking to solve a problem of antivibration, would not reasonably be expected or motivated to

look to torsion springs (MPEP §2141.01). Accordingly, applicants submit that Kalister constitutes non-analogous art.

Thus, applicants submit that Newman and Kalister are not combinable and even if combined do not teach or suggest all the claim limitations as required for a *prima facie* case of obviousness. Applicants further submit that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Newman or to combine the teachings of Newman and Kalister. Finally, applicants submit that there is no reasonable expectation of success (MPEP §2142).

In paragraph 14, the Office rejected claim 16 under 35 U.S.C. §103(a) as obvious over Newman in view of Griswold.

The Office acknowledged that Newman does not disclose the limitation of slots having a circular-arc shaped cross section.

However, the view was expressed that it would have been obvious to one of ordinary skill in the art to modify the cross-section of slots of Newman in view of the disclosure of Griswold.

The deficiencies of Newman and Griswold have been outlined above. Applicants submit that their combination does not cure these deficiencies.

Thus, applicants submit that Newman and Griswold are not combinable and even if combined do not teach or suggest all the claim limitations as required for a *prima facie* case of obviousness. Applicants further submit that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Newman or to combine the teachings of Newman

and Griswold. Finally, applicants submit that there is no reasonable expectation of success (MPEP §2142).

Applicants have shown above that claim 1 is not anticipated by Newman and Griswold and thus should be in condition for allowance. Claims 2 to 3, 6 to 9 and 11, which are directly or indirectly dependent on claim 1 should be equally allowable over these references. Applicants have also shown that claims 4 to 5, 10, 12 and 16 are not obvious in view of the specified combination of references and thus should also be allowable. Claims 13 to 15 which are directly or indirectly dependent on claim 12 should also be allowable.

Reconsideration of the application is respectfully requested.

Respectfully submitted,



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